

1 UNITED STATES PATENT AND TRADEMARK OFFICE

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3  
4 BEFORE THE BOARD OF PATENT APPEALS  
5 AND INTERFERENCES  
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8 *Ex parte* CARL E. WHITCOMB  
9

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11 Appeal 2007-2052  
12 Application 10/823,379  
13 Technology Center 3600  
14

15  
16 Decided: November 19, 2007  
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19 *Before* WILLIAM F. PATE, III, JENNIFER D. BAHR, and DAVID B.  
20 WALKER, *Administrative Patent Judges*.  
21  
22 PATE, III, *Administrative Patent Judge*.  
23

24 DECISION ON APPEAL  
25

26 STATEMENT OF CASE

27 Appellant appeals under 35 U.S.C. § 134 (2002) from a Final  
28 Rejection of claims 1-24, 26-29, 31-38, 40-41, and 60-63. Claims 25, 30,  
29 39, 42-59, and 64 stand withdrawn from consideration. We have jurisdiction  
30 under 35 U.S.C. § 6(b) (2002).

31 Appellant invented a plant container to address the problem of root  
32 circling. The invented plant container includes a base with a plurality of  
33 radially directed channels for guiding plant roots.

34 Independent claims 1 and 60 read as follows:

35 1. A plant container, comprising:

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1 a sidewall having a plurality of shoulders; and  
2 a base supported on the shoulders, the base having  
3 an upwardly facing surface with a plurality of  
4 radially directed channels.

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6 60. A plant container, comprising:  
7 a container sidewall; and  
8 a base secured to the container sidewall, the base  
9 having an upwardly facing surface with a plurality  
10 of radially directed channels.

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12 The prior art relied upon by the Examiner in rejecting the claims on  
13appeal is:

14	Waterer	603,492	May 3, 1898
15	Anderson	4,628,634	Dec. 16, 1986
16	Single	GB 2350272A	Nov. 29, 2000

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18 The Examiner rejected claims 1-4, 9-11, 13, 14, 26-28, 31, 35, 60, 62,  
19and 63 under 35 U.S.C. § 103(a) as being unpatentable over Single in view  
20of Waterer. The Examiner also rejected claims 5-8, 12, 15-24, 29, 32-34,  
2136-38, 40, 41, and 61 under U.S.C. § 103(a) as being unpatentable over  
22Single and Waterer, in further view of Anderson.

23

24 We AFFIRM-IN-PART.

25

26 ISSUE

27 Has Appellant shown that the Examiner failed to establish that one of  
28ordinary skilled in the art would modify the base of the plant container

9  
1disclosed in Single to incorporate the radial ribs provided on the stand of  
2Waterer?

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#### FINDINGS OF FACT

5 The record supports the following findings of fact (FF) by  
6preponderance of the evidence.

7 1. Single discloses a plant root container 5 including a sidewall 2  
8having a plurality of shoulders 26 and a base 18, 27 supported on the  
9shoulders, the base having an upwardly facing surface (Figs. 2, 4 and 10;  
10Single 3, ll.13-19; Single 4, ll. 34-44).

11 2. Waterer discloses a plant container including a side wall 2 and a  
12base 20 secured to the side wall, the base having an upwardly facing surface  
13with a plurality of radially directed channels formed between raised ribs 22  
14(Figs. 1 and 5; Waterer 1, ll. 54-60 and ll. 95-97).

15 3. The jardinière disclosed in Waterer is a plant container because  
16when in use, a plant is contained therein, even though the plant itself may be  
17within another container placed within the jardinière (Fig. 1).

18 4. The base of Waterer is secured by being supported around its  
19periphery by the bottom end of the sidewall (Fig. 1).

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#### PRINCIPLES OF LAW

22 A claim is anticipated under 35 U.S.C. § 102 “if each and every  
23element as set forth in the claim is found, either expressly or inherently  
24described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co.*

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1of *California*, 814 F.2d 628, 631 (Fed. Cir. 1987), *cert. denied*, 484 U.S. 827  
2(1987).

3 In addition, 35 U.S.C. § 103 “forbids issuance of a patent when ‘the  
4differences between the subject matter sought to be patented and the prior art  
5are such that the subject matter as a whole would have been obvious at the  
6time the invention was made to a person having ordinary skill in the art to  
7which said subject matter pertains.’” *KSR Int’l Co. v. Teleflex Inc.*, 127 S.Ct.  
81727, 1734 (2007). The Court stated that obvious analysis “should be made  
9explicit.” *Id.* at 1740-41, citing *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir.  
102006) (“[R]ejections on obviousness grounds cannot be sustained by mere  
11conclusory statements; instead, there must be some articulated reasoning  
12with some rational underpinning to support the legal conclusion of  
13obviousness”). However, “the analysis need not seek out precise teachings  
14directed to the specific subject matter of the challenged claim, for a court  
15can take account of the inferences and creative steps that a person of  
16ordinary skill in the art would employ.” *Id.*

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## 18 ANALYSIS

19 Claims 1-4, 9-11, 13, 14, 26-28, 31, 35, 60, 62, and 63

20 The Examiner rejected independent claim 1 noting that Single  
21discloses a plant container satisfying all of the limitations of claim 1 except  
22for radially directed channels provided on the upwardly facing surface of the  
23base (Final Rejection 2, ll. 14-17). The Examiner cites Waterer as disclosing  
24a jardinière for a plant container having a stand with radial ribs and asserts  
25that one of ordinary skill in the art would have been motivated to combine

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1Single with Waterer in order to permit water to flow from a central area of  
2the plant container (Final Rejection 2, ll. 17-21; and Ans., 3, ll. 16-20). The  
3Examiner further asserts that the channels of Waterer are structurally  
4capable of guiding roots (Ans., 4, ll. 18-23).

5 Appellant contends that the subject matter of claim 1 would not have  
6been obvious to one of ordinary skill in the art and that the Examiner has not  
7presented sufficient evidence as to why one of ordinary skill would combine  
8Single and Waterer (Br., 9, l. 26-Br., 15, l. 12). The Appellant also contends  
9that the Examiner's rejection is based on impermissible hindsight analysis  
10(Br., 15, l. 13-Br., 17, l. 11). We agree with the Appellant.

11 The Examiner has failed to articulate reasoning with rational  
12underpinning to support the conclusion that it would have been obvious to  
13one of ordinary skill to combine Single and Waterer in the manner  
14suggested. The record fails to show why one of ordinary skill would have  
15looked to the jardinière of Waterer as disclosing a stand for elevating a plant  
16container to allow drainage of water from a plant container; extract the  
17radially extending ribs of the stand; and provide such ribs on the base of the  
18plant container of Anderson.

19 The motivation articulated by the Examiner is that provision of such  
20ribs allows water to flow from a central area of the plant container (Final  
21Rejection 2, ll. 17-21; and Ans., 3, ll. 16-20). However, the Single reference  
22does not address the issue of water flow within the plant container or the  
23desirability of directing water from the central area of the plant container  
24(Br., 13, ll. 13-14; and Br., 14, ll. 11-14). While obviousness analysis does  
25not require the Examiner to identify specific teachings, suggestions, or

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1motivations in the references in order to combine prior art references, the  
2Examiner should provide articulated reasoning with rational underpinnings  
3in support of obviousness. *See KSR*, 127 S.Ct. at 1740-41. The rational  
4nexus between providing ribs for elevating a plant container for drainage as  
5disclosed in the jardinière of Waterer and providing ribs at a base of the  
6plant container disclosed in Single has not been established by the Examiner.

7       Accordingly, we conclude that although the Examiner has shown all  
8claimed elements were known in the prior art, the Examiner has not given a  
9rational reason as to why one skilled in the art would have combined the  
10prior art elements to make Appellant’s claimed invention. Thus, Appellant  
11has shown that the Examiner erred in rejecting independent claim 1 and  
12claims 2-4, 9-11, 13, 14, 26-28, 31, and 35, ultimately dependent on claim 1.

13       Independent claim 60 does not have the limitation requiring a plurality  
14of shoulders that is recited in claim 1. We find that claim 60 is anticipated  
15by Waterer which discloses each and every limitation of the claim (FF 2-4).  
16Waterer also shows that the channels are free from obstructions as recited in  
17dependent claim 62, and that the ribs define eight channels as recited in  
18dependent claim 63. Because we have found that claims 60, 62, and 63 are  
19anticipated by Waterer, we affirm the § 103 rejection of these claims,  
20anticipation being “the epitome of obviousness.” *See In re McDaniel*, 293  
21F.3d 1379, 1385 (Fed. Cir. 2002) (citations and internal quotation marks  
22omitted).

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1      Claims 5-8, 12, 15-24, 29, 32-34, 36-38, 40, 41, and 61

2 The Appellant has also established that the Examiner erred in  
3 rejecting dependent claims 5-8, 12, 15-24, 29, 32-34, 36-38, 40, and 41,  
4 because these claims are ultimately dependent on claim 1.

5        Claim 61 recites that the base includes “protrusions that are received  
6 within recesses in the container sidewall.” The Appellant has further  
7 established that the Examiner erred in rejecting claim 61 because the  
8 Examiner’s rejection relies upon combining Single and Waterer as discussed  
9 *supra* relative to independent claim 1.

## 10

11 CONCLUSION OF LAW

Based on the record before us, the Appellant has shown that the Examiner failed to establish that one of ordinary skilled in the art would modify the base of the plant container disclosed in Single to incorporate the radial ribs provided on the stand of Waterer.

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17 ORDER

18           1. The Examiner's rejections of claims 1-24, 26-29, 31-38, 40-41, and  
1961 are REVERSED.

20           2. The Examiner's rejection of claims 60, 62, and 63 is AFFIRMED.

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1 No time period for taking any subsequent action in connection with  
2this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R.  
3§ 1.136(a)(1)(iv) (2006).

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AFFIRMED-IN-PART

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